



BD of Appeal  
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PATENT

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January 26, 2004

(Date)

*Adeel S. Akhtar*

Adeel S. Akhtar, Reg. No. 41,394

Appeal No. : 2004-0582  
Applicant : Fazan et al.  
Appl. No. : 09/037,945  
Filed : March 10, 1998  
For : STREAMLINED FIELD ISOLATION PROCESS  
Examiner : George R. Fourson, III  
Group Art Unit: 2823

REQUEST FOR CORRECTION OF DOCKETING NOTICE

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicants respectfully request the correction of the Docketing Notice mailed on January 9, 2004. Specifically, both the Reply Brief and the Request for Hearing were incorrectly listed as being filed on September 29, 2003. The correct filing date for both the Request Brief and a Request for Hearing is May 23, 2003. In addition, Applicants filed a Confirmation of Request for Oral Hearing on December 1, 2003. Copies of both of these documents, indicating the aforementioned dates, are enclosed. A copy of the Docketing Notice is also included.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: January 26, 2004

By: *Adeel S. Akhtar*  
Adeel S. Akhtar  
Registration No. 41,394  
Attorney of Record  
Customer No. 20,995  
(415) 954-4114

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KNOBBE MARTENS OLSON & BEAR LLP,  
2040 MAIN STREET  
FOURTEENTH FLOOR  
IRVINE, CA 92614

Paper No: 33  
Appeal No: 2004-0582  
Appellant: FAZAN, PIERRE C.  
Application: 09/037,945

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**PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES**

**Board of Patent Appeals and Interferences  
Docketing Notice**

Application 09/037,945 was received from the Technology Center at the Board on December 30, 2003 and has been assigned Appeal No: 2004-0582.

A review of the file indicates that the following documents have been filed by appellant:

Appeal Brief filed on: January 28, 2003  
Reply Brief filed on: September 29, 2003  
Request for Hearing filed on: September 29, 2003

In all future communications regarding this appeal, please include both the application number and the appeal number.

The mailing address for the Board is:

**BOARD OF PATENT APPEALS AND INTERFERENCES  
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By order of the Board of Patent Appeals and Interferences



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**UTILITY/DESIGN PATENT**  
(amend/final amend/appeal)

Date: 5/23/03  
Date of Action: 5/23/03

Rec'd in the USPTO on the date stamped hereon via Certificate of Mail:

Docket #: MICRON CDSC1 Applicant: Fazun et al.

Title: STREAMLINED FIELD ISOLATION PROCESS

App No.: 09/037,945 Filed: 3/10/98

VERIFIED BY: Asst: JP Atty: ASA/DKJ QC: Y

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|--|--|
| <input checked="" type="checkbox"/> Transmittal Letter                                   | <input type="checkbox"/> Req for Drawing Changes/Corrections               |
| <input type="checkbox"/> Amendment in _____ pgs  | <input type="checkbox"/> _____ sheets of RED-Lined Drawings                |
| <input type="checkbox"/> _____ Month Extension Requested                                 | <input type="checkbox"/> Notice of Appeal in Duplicate                     |
| <input type="checkbox"/> Information Disclosure Statement; with PTO-1449 w/ _____ Ref(s) | <input type="checkbox"/> Appeal Brief in _____ pgs in Triplicate           |
| <input type="checkbox"/> Terminal Disclaimer in _____ pgs                                | <input type="checkbox"/> Request for Oral Hearing                          |
| <input type="checkbox"/> Sequence Submission Statement                                   | <input checked="" type="checkbox"/> \$ <u>230.00</u> Check for Filing Fees |
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(9/17/02)

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⑈010443⑈ ⑆121000248⑆4159335140⑈

*JP*

Case Docket No. MICRON.003C1

Date: May 23, 2003

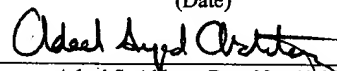
Page 1

In re application of : Fazan et al.  
Appl. No. : 09/037,945  
Filed : March 10, 1998  
For : STREAMLINED FIELD  
ISOLATION PROCESS  
Examiner : George R. Fourson, III  
Art Unit : 2823

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May 23, 2003

(Date)

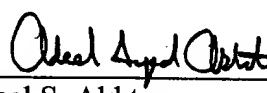
  
Adeel S. Akhtar, Reg. No. 41,394

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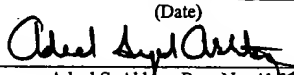
Sir:

Transmitted herewith is a Reply Brief and Request for Oral Hearing to the Board of Patent Appeals are:

- (X) Appellants hereby request an oral hearing. The fee set forth in 37 C.F.R. 1.17(d) is enclosed.
- (X) A check in the amount of \$280 to cover the foregoing fees is enclosed.
- (X) Please charge any additional fees or credit overpayment to Deposit Account No. 11-1410.
- (X) Return prepaid postcard.

  
Adeel S. Akhtar  
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Attorney of Record  
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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Fazan et al.	)	Group Art Unit 2823
Appl. No.	:	09/037,945	)	
Filed	:	March 10, 1998	)	I hereby certify that this correspondence and all
For	:	STREAMLINED FIELD	)	marked attachments are being deposited with
		ISOLATION PROCESS	)	the United States Postal Service as first-class
Examiner	:	George R. Fourson, III	)	mail in an envelope addressed to: Commissioner
			)	for Patents, P.O. Box 1450, Alexandria, VA
			)	22313-1450, on
			)	May 23, 2003
			)	(Date)
			)	
			)	Adeel S. Akhtar, Reg. No. 41,594

**REPLY BRIEF AND REQUEST FOR ORAL HEARING**

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Dear Sir:

In response to the Examiner's Answer in this appeal, mailed on March 24, 2003, Appellants' reply as follows:

**I. Arguments Raised by Examiner's Answer and Appellants' Responses:**

**A. The inferred utility of an undisclosed modification of an embodiment is motivation or suggestion to modify.**

**1. Examiner's Argument**

The Examiner continues to assert the following:

Appellant argues that the reference discloses disadvantages of omitting the wet oxidation stage and must instead disclose desirability. However it is sufficient that the reference suggest that omission of the wet oxidation step would result in a process having *utility* which in this case is formation of a field oxide useful as an isolation region.

Examiner's Answer p. 5 (*emphasis added*).

2. *Appellants' Response*

Appellants do not argue that, since the reference discloses disadvantages of omitting the wet oxide step, then *the reference* must disclose the desirability of omitting the step. Instead, Appellants argue that the Examiner must provide a suggestion or motivation *from the art* which evidences the desirability of omitting the wet oxide step. Rather than showing the desirability of omitting German's first step, the only motivation or suggestion provided by the Examiner is his conclusion that the remaining dry oxide step offers implicit *utility*. However, the possible utility of a modified embodiment not disclosed in the asserted art is *not*, by itself, adequate suggestion or motivation from the art to perform the modification in the first place. In other words, the Examiner's conclusion that it is possible that German could be so modified, *if* desired, does not support the rejection of Appellants claims. "Utility" cannot serve as a reason to stray from the teachings of the art in general and applied references in particular, which teach the use of an additional wet oxidation step.

**B. The inferred utility of an undisclosed modification of an embodiment is sufficient motivation or suggestion to overcome disclosed, explicit disadvantage of the modification.**

1. *Examiner's Argument*

The Examiner has also continued to assert the following:

Appellant argues that the reference must disclose elimination of the first oxidation step. However, this is not necessary. As discussed above, the reference suggests elimination of the step in disclosing the function of the step *in the event that the disclosed function is not desired* to be obtained and, as discussed above, in comparison to a process in which the step is eliminated. It is clear from the teachings of the reference that a useful field oxide would be produced by the second step alone *although the process would be longer in duration*.

Examiner's Answer p. 6 (*emphasis added*)

2. *Appellants' Response*

Appellants have argued above that, without more, the predicted utility of a modified embodiment is not a replacement for the required suggestion or motivation from the art to so modify. In addition, Appellants further submit that predicted, but undisclosed, utility is an especially inadequate motivation or suggestion to modify an embodiment when the reference

explicitly discloses that so modifying would be disadvantageous. It should be noted that the Examiner agrees that elimination of the first step would be disadvantageous as "the process would be longer in duration." Examiner's Answer p. 6. Other than repeatedly stressing that the first step could be eliminated if the skilled artisan wanted to make the fabrication process more time consuming, the Examiner has failed to provide any counterbalancing reasons from the art as to *why the skilled artisan would be motivated to modify German's process to be less efficient* by eliminating the first step. By stating that the wet oxidation step could be eliminated "*in the event* that the disclosed function is not desired, the Examiner again fails to appreciate that showing *desirability* is part of a *prima facie* case of obviousness. See *In re Deminski*, 230 U.S.P.Q. 313, 315 (Fed. Cir. 1986) ("There is nothing in the prior art references, either singly or in combination, 'to suggest the desirability, and thus the obviousness,' of designing the valve assembly so that it can be removed as a unit.")(emphasis added).

**C. Non-preferred embodiments in the prior art are relevant disclosure for the purposes of determining patentability of an invention even if the preferred embodiments teach away from these non-preferred embodiments.**

**1. Examiner's Argument**

The Examiner argues that "a prior art opinion that a claimed invention is not preferred for a particular limited purpose, does not preclude utility of the invention for that or another purpose, or even preferability of the invention for another purpose." Examiner's Answer p. 6. In support of the foregoing argument, the Examiner cites a number of cases for the proposition that non-preferred embodiments are still relevant prior art and, also, that preferred embodiments do not teach away from non-preferred embodiments.

**2. Appellants' Response**

Appellants do not challenge the Examiner's statement that "a prior art opinion that a claimed invention is not preferred for a particular limited purpose, does not preclude utility of the invention for that or another purpose, or even preferability of the invention for another purpose." However, Appellants assert that this statement is inapplicable to both Appellants' arguments and the present facts. Specifically, Appellants do not dispute that non-preferred embodiments are relevant prior art.

Instead, Appellants argue that *modifications of a preferred embodiment* in a reference, which are *not disclosed as an embodiment at all* in that reference (whether preferred or non-preferred), must be supported by some motivation or suggestion from the prior art other than mere implied utility alone. Furthermore, despite the case law cited by the Examiner as supporting the relevance of non-preferred embodiments to a patentability determination, are inapplicable as the Examiner is not basing his rejections on any identified *embodiment* from the art. In other words, the relevance of non-preferred embodiments is inapplicable, since the Examiner has not based his rejections on *any* disclosed embodiments, whether preferred or not. Instead of citing an actual embodiment from the art, the Examiner is modifying a prior art embodiment in an admittedly undesirable fashion without provided any justification from the art for doing so other than the fact that some (diminished) utility would remain. Reduced utility hardly serves as a suggestion to modify the teachings of the prior art.

## II. Conclusion

In view of the foregoing amendments, Appellants respectfully submit that the rejections of the pending claims over German '885 alone or in view of Marshall et al. are improper and should be withdrawn.

## III. Request for Oral Hearing

Pursuant to 37 C.F.R. § 1.194, Appellants respectfully request an Oral Hearing in this Appeal. This Request is also made in a separate paper filed herewith, and is accompanied by the fee set forth in 37 C.F.R. §1.17(d).

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: May 23, 2003

By: Adeel S. Akhtar  
Adeel S. Akhtar  
Registration No. 41,394  
Attorney of Record  
(415) 954-4114



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December 1, 2003

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EXAMINER: George R. Fourson, III  
USPTO FACSIMILE No.: 703-872-9306  
USPTO REFERENCE: Applicant: Fazan et al.  
Serial No.: 09/037,954  
Filed: March 10, 1998  
Title: STREAMLINED FIELD ISOLATION PROCESS  
PROSECUTING ATTORNEY: Adeel S. Akhtar / PHONE No.: (415)217-8384  
ATTORNEY DOCKET No.: MICRON.003C1  
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EXAMINER: George R. Fourson, III  
USPTO FACSIMILE No.: 703-872-9306  
USPTO REFERENCE: Applicant: Fazan et al.  
Serial No.: 09/037,954  
Filed: March 10, 1998  
Title: STREAMLINED FIELD ISOLATION PROCESS  
PROSECUTING ATTORNEY: Adeel S. Akhtar / PHONE No.: (415)217-8384  
ATTORNEY DOCKET No.: MICRON.003C1  
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MESSAGE: *Attached for filing in the above-referenced application are:*☒ TRANSMITTAL LETTER☒ COPY OF ORDER RETURNING  
UNDOCKETED APPEAL TO  
EXAMINER IN 3 PAGES☒ CONFIRMATION OF REQUEST FOR  
ORAL HEARING IN 2 PAGES☐ DECLARATION BY INVENTORS☐ REQUEST FOR DRAWING CHANGES  
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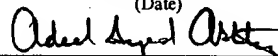
Applicant(s) : Fazan et al.  
Appl. No. : 09/037,945  
Filed : March 10, 1998  
For : STREAMLINED FIELD  
ISOLATION PROCESS  
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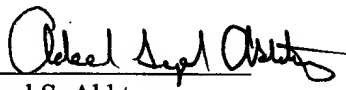
## TRANSMITTAL LETTER

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Enclosed for filing in the above-identified application are:

- (X) Confirmation of Request for Oral Hearing in 2 pages.
- (X) Copy of Order Returning Undocketed Appeal to Examiner in 3 pages.
- (X) Return prepaid postcard.



Adeel S. Akhtar  
Registration No. 41,394  
Attorney of Record  
Customer No. 20,995  
(415) 954-4114

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Fazan et al.  
Appl. No. : 09/037,945  
Filed : March 10, 1998  
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Examiner : George R. Fourson, III

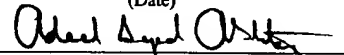
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Adeel S. Akhtar, Reg. No. 41,394CONFIRMATION OF REQUEST FOR ORAL HEARING

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United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicants hereby confirm a previous request for an Oral Hearing in this Appeal, pursuant to 37 C.F.R. § 1.194. The previous request for an Oral Hearing under 37 C.F.R. § 1.194 was contained in both Applicants' Reply Brief and the accompanying transmittal, *i.e.* a separate paper, filed on May 23, 2003. This prior request was accompanied by the fee set forth in 37 C.F.R. § 1.17(d). Furthermore, the enclosed Board Notice evidences that this fee has been paid. Accordingly, no fee is due for this Request.

Appl. No. : 09/037,945  
Filed : March 10, 1998

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: December 1, 2003

By: Adeel S. Akhtar

Adeel S. Akhtar  
Registration No. 41,394  
Attorney of Record  
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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte PIERRE C. FAZAN, VIJU K. MATHEWS  
and NANSENG JENG

---

Application 09/037,945

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received at the Board of Patent Appeals and Interferences on September 15, 2003. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

A fee for an Oral Hearing was charged on July 9, 2003. In a review of the file, the Oral Hearing Notice was not found.


Accordingly, it is

Application 09/037,945

ORDERED that the application is returned to the Examiner for either providing a copy of the Oral Hearing Notice or removal of such charge, and for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By:

  
CRAIG FEINBERG  
Program and Resource Administrator  
(703) 308-9797

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